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TABLE OF CONTENTS

1. REAL PARTY IN INTEREST	Page 1
2. RELATED APPEALS AND INTERFERENCES	Page 1
3. STATUS OF THE CLAIMS	Page 2
4. STATUS OF ANY AMENDMENT FILED SUBSEQUENT TO FINAL REJECTION.....	Page 2
5. SUMMARY OF THE INVENTION	Page 3
6. ISSUES PRESENTED	Page 6
7. GROUPING OF CLAIMS	Page 7
8. ARGUMENTS WITH RESPECT TO ISSUES PRESENTED FOR APPEAL.....	Page 7
9. CONCLUSION	Page 22
10. APPENDIX OF CLAIMS	Page 23



PATENT
29250-000661/US

**IN THE U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT: William K. Birnie et al. CONF. NO.: 8093
SERIAL NO.: 09/384,646 GROUP: 2684
FILED: August 27, 1999 EXAMINER: R. Perez-Gutierrez
FOR: ENHANCED ROAMING NOTIFICATION

**BRIEF ON BEHALF OF APPELLANT FILED
UNDER PROVISION OF 37 C.F.R. § 1.192**

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DEC 27 2002
Technology Center 2600

Assistant Commissioner for Patents
Washington, D.C. 20231

December 23, 2002

Dear Sir:

This is an Appeal from the Final Rejection of May 23, 2002 (Paper No. 12), of claims 1-18. This Appeal Brief is submitted to support the Notice of Appeal filed on October 22, 2002.

(1) **REAL PARTY IN INTEREST:**

The real party in interest in the present appeal is Lucent Technologies, Inc.

(2) **RELATED APPEALS AND INTERFERENCES:**

Appellant submits that no other appeals or interferences are known to Appellant, Appellant's legal representative, or the Assignee of

the present application, which would directly affect or be affected by, or have a bearing on the Board's decision in the pending Appeal.

(3) STATUS OF THE CLAIMS:

Appellant submits that claims 1-18 are pending in the application. Claims 1, 8, 15, and 17 are independent. Claims 1-18 stand rejected and are the claims on Appeal. A complete copy of pending claims 1-18 is provided in the Appendix of Claims attached hereto.

Claims 1, 8, 15, and 17 stand finally rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,255,307 to Mizikovsky (hereinafter Mizikovsky) in view of U.S. Patent No. 6,018,655 to Bartle et al. (hereinafter Bartle).

Claims 2-7, 9-14, 16, and 18 stand finally rejected under 35 U.S.C. §103 as being unpatentable over Mizikovsky in view of Bartle, and further in view of U.S. Patent No. 6,201,957 to Son et al. (hereinafter Son).

(4) STATUS OF ANY AMENDMENT FILED SUBSEQUENT TO FINAL REJECTION:

A Request for Reconsideration was filed on July 23, 2002, with remarks (entry of which is respectfully requested). In an Advisory Action mailed August 13, 2002, the Examiner indicated that the arguments had been considered but were not persuasive. Appellant filed a Notice of

Appeal on October 22, 2002, and is filing this Appeal Brief, in response to the final Office Action of May 23, 2002.

(5) SUMMARY OF THE INVENTION:

The present invention relates to a mobile wireless station MS which provides an audible alert to the user of an imminent or directed handoff to a carrier which would charge the user for roaming, while the mobile station MS is on a call (specification, page 2, lines 3-6). The station MS may be configured to either refrain from following a handoff direction, or automatically terminate or release the call within a short predetermined time period after the audible alert, unless the user performs an act of assent before expiration of the time period (Id. at lines 6-10). Such acts of assent may include pressing a predetermined key or speaking a predetermined command, before expiration of the time period (Id.).

When a handoff is between networks of different types, such as from a digital Personal Communications Services (PCS) system to an analog cellular or Analog Mobile Phone System (AMPS) network, which would charge the user of the mobile station MS as a roamer, the charges can be particularly expensive (specification, page 1, lines 20-26). Such handoffs, which are known as hard handoffs, are rather common because the configuration of PCS networks in the United States is incomplete and primarily existing in densely populated areas (Id. at lines

26-28). Customer dissatisfaction with the primary carrier may result from the unexpected roaming charges associated with hard handoffs, which occur during calls (Id. at lines 28-30).

FIG. 1 of the application illustrates a mobile terminal or station MS, a cellular arrangement of base stations BS1 of the primary carrier network to which the mobile station MS is assigned, and a cellular arrangement of base stations BS2 of a secondary carrier network on which the station MS may incur roaming charges (specification, page 3, lines 10-15). When the mobile station MS is on a call and travels within the confines of the coverage area of the network having base stations BS1, so-called soft handoffs are made between these base stations BS1 to maintain the call with the one of the base stations BS1 having a best signal strength or signal-to-noise ratio as measured by the mobile station MS (Id. at lines 15-18). This typically results in the mobile station MS being in communication with the closest of the base stations BS1, such as base station 60 in FIG. 1 (Id. at lines 18-20).

When the mobile station MS is on a call via the nearest base station 60, and passes through a boundary B1 of the coverage area of the base stations BS1, a handoff to a nearest base station 80 of the base stations BS2 of the secondary carrier may be necessary in order to maintain the call (Id. at lines 20-23). Where the handoff is a hard handoff, e.g., from a PCS system to an AMPS network, an Analog Handoff Direction Message (AHDM) may be sent to the mobile station MS from

the base station 60, which is currently servicing the call (specification, page 3, lines 24 - page 4, line 2). The AHDM may identify the nearest base station 80 of the secondary analog carrier for receiving the handoff according to a system identifier SID associated with that carrier (specification, page 3, line 30 - page 4, line 2).

According to one embodiment of the present invention, the mobile station MS may receive such a handoff message indicating an imminent handoff from the primary carrier network to an identified secondary carrier network during a call (specification, page 5, lines 14-22). In response, the mobile station MS determines whether the indicated handoff to the secondary carrier will result in additional roaming charges (Id. at lines 19-26). To do this, the mobile station MS checks an SSPR database 33 (FIG. 2) including a list of SIDs of systems with which the primary carrier has a roaming agreement, and a field ROAM_IND indicating whether the mobile station user will incur charges with each system in the database 33 (specification, page 5, lines 19-26; page 6, lines 5-14). The mobile station MS compares the SID received in the handoff message with the SSPR database 33 and determines that roaming charges would be incurred by the identified system if one of the following occurs: the received SID does not match any SID in the database 33, or the ROAM_IND field corresponding to the received SID indicates that roaming charges will be incurred (Id.).

If roaming charges will be incurred, the mobile station MS initiates one or more actions, including the sounding of an alert (e.g., the sounding of a buzz or beep) (specification, page 5, lines 23-27). In addition to the audible alert, other actions may be performed: the displaying of a prompt to the user; a timer is set for a predetermined time period, and a vibrating alert is activated (specification, page 5, lines 28 - page 6, line 3). The mobile station user may respond to the audible alert by performing an action to actively indicate whether he/she wishes to continue the call (specification, page 6, lines 15-17). For example, in one embodiment, the user may press a predetermined key of the mobile station MS, or speak a predetermined command, before expiration of the predetermined time period in order to continue the call (Id.). Accordingly, the handoff will not be formed and the call will end if the user does not perform such an action within the predetermined time period (Id. at lines 17-21).

(6) ISSUES PRESENTED

ISSUE 1: Whether claims 1 and 8 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle, and whether claims 2-5 and 9-12 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle and Son.

ISSUE 2: Whether claims 15 and 17 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle, and whether claims 16 and 18 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle and Son.

ISSUE 3: Whether claims 6 and 13 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle and Son.

ISSUE 4: Whether claims 7 and 14 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle and Son.

(7) GROUPING OF CLAIMS

Applicant respectfully requests that the following claims be grouped together as indicated:

Group I: Claims 1-5 and 8-12.

Group II: Claims 6 and 13.

Group III: Claims 7 and 14.

Group IV: Claims 15-18.

(8) ARGUMENTS WITH RESPECT TO ISSUES PRESENTED FOR APPEAL

ISSUE 1: Whether claims 1 and 8 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle, and whether claims 2-5 and 9-12 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle and Son.

With respect to claims 1 and 8, the Examiner asserts that Mizikovsky discloses a mobile station 18 (wireless terminal) and a

method for alerting the mobile station user of a handoff from a first communication service station 12 to a second communication service station 25, as shown in Figure 2 (Paper No. 12, section 4, page 3). The Examiner further asserts that Mizikovsky discloses that the mobile station 18 comprises a transceiver 32 (receiver) that receives a handoff indicating message in Figure 8, column 9, lines 28-31 and 45-57, and claim 7; a memory 44 containing System Identification Data SID_s (acceptable identifier) in Figure 8 and column 13, lines 50-54; and a processor 60 that determines if a received System Identification Data SID_r (received identifier) of the second communication service station 25 matches the stored SID_s in Figure 8, column 13, lines 50-54, and column 14, lines 26-32 (Paper No. 12, section 4, page 3). The Examiner states that Mizikovsky discloses that the processor 60 activates a visual status indicator 48 during the call if the received SID_r does not match the stored SID_s in the abstract, column 3, line 58 through column 4, line 8, and column 13, lines 54-59 (Paper No. 12, section 4, page 4).

The Examiner admits that Mizikovsky fails to disclose that the memory 44 contains a collection of acceptable identifiers (i.e., a plurality of SID 's) (Id.). However, the Examiner asserts that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a plurality of SID 's in the memory 44 of Mizikovsky because Mizikovsky clearly discloses that the status indicator 48 of the mobile station is selectively controlled as the mobile station moves

through service cells, which are serviced by different providers (having different SID's) (Id.).

The Examiner also admits that Mizikovsky fails to disclose a status indicator 48, which outputs an audible or a vibrating indication or alert to the user (Id.). The Examiner asserts that Bartle discloses a cellular telephone 10 (wireless terminal) and a method for indicating to the cellular telephone user of an imminent inter-system handoff in which the cellular telephone 10 provides a visual, vibrating, or audible alert to the user upon determining that the handoff is imminent in Figure 1 and column 9, lines 38-58 (Paper No. 12, section 4, pages 4-5). The Examiner asserts that it would be obvious to a person of ordinary skill in the art at the time the invention was made to further modify the teachings of Mizikovsky with the teachings of Bartle to provide audible or vibrating alerts when a inter-system handoff is imminent, "in order to enable the user to be aware of the mobile telephone status (i.e., roaming) without needing to constantly look at a display of the mobile telephone to know the current status of the telephone, specially [sic] when the user is currently on the telephone call." (Paper No. 12, section 4, page 5).

The Examiner's combination of Mizikovsky and Bartle is based on hindsight, using Applicants' disclosure as a blueprint, which is not permitted. C.R. Bard, Inc. v. M3 Systems, 48 U.S.P.Q. 1225 (C.A.F.C. 1998); Interconnect Planning Corp. v. Feil, 227 U.S.P.Q. 543 (C.A.F.C. 1998); In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (C.A.F.C. 1998).

Specifically, the Examiner's stated motivation for combining the references has apparently been gleaned directly from Appellants' own disclosure. In particular, the Examiner's motivation seems to merely restate the problem set forth in page 1, lines 12-19, of Appellants' specification, that "a visual indication would not be seen or noticed by the user when the terminal is in active use...[c]onsequently, the user is not generally aware of a change from a non-roaming status to a roaming status...while on a call." The Examiner has provided no reference to any teaching in the prior art recognizing the drawbacks of visual indicators.

Appellants point out that teaching or motivation to combine references must be based on objective evidence of record, i.e., based on an analysis of the prior art. In re Lee, 61 U.S.P.Q.2d 1430, 1433 (C.A.F.C. 2002). In determining the obviousness of an invention under 35 U.S.C. § 103, "[t]he issue...is whether the teachings of the prior art, *in and of themselves and without the benefits of [Applicant's] disclosure*, make the invention as a whole, obvious." In re Sponnoble, 160 U.S.P.Q. 237, 243 (C.C.P.A. 1969).

Since the Examiner has not provided any such evidence showing a teaching or motivation to combine, but instead has merely used Applicants' disclosure as a blueprint, Applicants respectfully submit that the combination of Mizikovsky and Bartle is improper.

Even assuming for the sake of argument that proper motivation existed for combining Mizikovsky and Bartle, Applicants respectfully

submit that the resultant combination fails to disclose every claimed feature. In order to establish *prima facie* obviousness, all claim limitations must be taught or suggested in the prior art. In re Royka, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 1 and 8 each recite a method of alerting a wireless terminal user of a handoff of a call from a first communication service station to a second communication service station by determining whether a received identifier of the second communication service station is at least one of a collection of acceptable identifiers, and producing an alert during the call if the received identifier is not at least one of the collection of identifiers. Neither Mizikovsky nor Bartle discloses this feature.

Appellants argued that none of the cited prior art references discloses the step of determining whether a received communication service station identifier is one of a collection of acceptable identifiers (Amendment of 2/26/2000, page 8). The Examiner responds by citing Mizikovsky, column 3, lines 41-45 as "clearly disclos[ing] that the status indicator 48 of the mobile station (wireless terminal) is selectively controlled as the mobile station moves through service cells that are serviced by different providers (e.g., having different System Identification Data (SID's))." (Paper No. 12, section 6, page 9).

Mizikovsky expressly notes that in conventional cellular mobile telephone systems, there is an inability to indicate a change in HOME/ROAM status when the mobile station is in active mode, i.e.,

during an ongoing call (Mizikovsky, column 2, lines 12-22). According to Mizikovsky, a mobile station can only change its status by comparing a system identification data (SID) code received from a base station with an SID code stored in the mobile station, and since the SID code can only be transmitted through a forward control channel, the mobile station's HOME/ROAM determination is locked when the mobile station is conducting a call (Id.).

Mizikovsky solves this problem by allowing the base station to which an active call is being handed off to receive the mobile station's identifier in order to match it to one of a collection of stored mobile station identifiers in the base station. Accordingly, if the received mobile station identifier does not match one of the stored identifiers in the base station, the base station will send a ROAM indicator status order control message over the forward voice channel to the mobile station. See Mizikovsky, column 9, line 21 through column 10, line 10. If the received mobile station identifier matches one of the stored identifiers, the base station alternatively sends a HOME indicator status message over the forward voice channel. Accordingly, the mobile station of Mizikovsky performs no comparison of a received identifier (SID) with any stored identifier during an active call.

That Mizikovsky's disclosed mobile station does not perform any comparisons of base station identifiers during an act of call is clearly shown in Figure 4 of Mizikovsky. While Figure 3 of Mizikovsky indicates

the processing of the mobile station and the base station when the mobile station roams into a visited network in idle mode, Figure 4 discloses the situation where the mobile station roams into a visited system during an active of call. As shown in Figure 3, the mobile station receives a SID from a base station over the forward control channel in order to compare it to the stored SID. According to this comparison, the mobile station will determine its status as either HOME or ROAM. On the other hand, Figure 4 does not disclose the mobile station performing any comparison of a received SID to a stored SID. Rather, Figure 4 shows that the base station analyzes the mobile station identification data (ESN, MIN I, MIN II) to determine the operating status indication of the mobile station as either HOME or ROAM. After this determination is made by the base station, it sends an operating status indication order message to the mobile station, "thereby driving the HOME/ROAM indicator to provide a suitable indication." (Mizikovsky, column 10, lines 11-17).

In the Advisory Action of August 13, 2002 (Paper No. 15) the Examiner argues that Mizikovsky clearly suggests that during active mode the mobile station receives an identifier (SID_r) from the base station and compares it to the stored SID to determine the HOME/ROAM indication, citing column 10, lines 4 and 5 of Mizikovsky (Paper No. 15, section 2, page 3). Appellants respectfully submit that column 9, line 67 through column 10, line 5 of Mizikovsky discloses a situation where a

roaming base station transmits a HOME indicator status order control message to the mobile station, which would override a ROAM indication that would normally result if the mobile station were to receive the base station's SID_r and compare it to the stored SID_s . However, Mizikovsky makes it clear that such a hypothetical comparison cannot be performed by the mobile station when it is in active mode. Specifically, column 2, lines 12-20 of Mizikovsky indicates that there is an inability for the mobile station to receive an SID code while in active mode because the SID code is transmitted from a base station on the forward control channel, which the mobile station can only receive in its idle mode.

The Examiner correctly notes that this section of column 2 in Mizikovsky discloses the conventional cellular telephone practice of transmitting the SID from a base station to a mobile station (Paper No. 15, section 2, page 2). However, Mizikovsky discloses that "[i]t is appreciated that, *in accordance with conventional cellular telephone practice*, a system identification code is not transmitted to the mobile station when in its active mode, even if the mobile station is handed off to a cell in a 'visited' system. Thus, heretofore, when mobile station 18 traveled from cell X2 to cell Y5, the HOME indication that was produced *at the time that the mobile station was in its idle mode* in cell X2 remained (column 10, lines 25-33, referring to the first caption under MOBILE STATION in Figure 4). Accordingly, Mizikovsky discloses that the base station must determine changes to the HOME/ROAM status for the

mobile station in active mode, and send an indicator status order control message to the mobile station over the forward voice channel to allow the mobile station to indicate the correct status. See also Mizikovsky at column 10, lines 20-24 and lines 52-55.

There is no explicit disclosure in Mizikovsky of a mobile station comparing a received identifier of a mobile station to a stored identifier during a call as recited in claims 1 and 8. If such were the case, as argued by the Examiner¹, there would never be a need in Mizikovsky's system for a roaming base station to generate and transmit a ROAM indicating status order control message to a roaming mobile station (as disclosed in Figure 4; column 10, lines 20-24; and column 12, lines 44-51 of Mizikovsky) because the mobile station would have generated such a ROAM indication based on this alleged comparison of SID_r and SID_s.

In addition, Mizikovsky explicitly discloses that the mobile station only stores the SID identifying the particular system which the mobile station subscribes (Mizikovsky, column 6, lines 10-13). The Examiner acknowledges this fact in Paper No. 12, section 4, page 4, and yet still asserts that it would have been "clearly obvious" that Mizikovsky's invention was "made to include a plurality of SID_s in the mobile station's memory because the mobile station is selectively controlled as [it] moves through service cells that are serviced by different providers (e.g., having different SID's)." (Id.)

¹ See Paper No. 15, section 2, page 3.

Appellants respectfully submit that the Examiner fails to provide any showing or teaching in Mizikovsky that a mobile station stores more than one SID. Even when the mobile station disclosed by Mizikovsky is not on the call (e.g., in idle mode), it only compares the SID_r received from a roaming system's base station to one stored SID to determine its status (see Mizikovsky, column 7, lines 23-39). Although Mizikovsky discloses that the home system of the mobile station may have an agreement with a roaming system, thereby granting the mobile station a preferred status in the roaming system, Mizikovsky clearly discloses that it is up to the roaming base station to make this determination by comparing the mobile station's identification data to stored identification data (Id. at column 7, lines 52-67, and column 9, lines 58-67). The roaming base station performs this function regardless of whether the mobile station is in idle or active mode (Id.).

For the reasons discussed above, Mizikovsky *teaches away* from comparing a received identifier of a base station to a stored identifier during a call, and from comparing a received identifier to a collection of acceptable identifiers whether or not the mobile station is on a call. Therefore, the Examiner has failed to show where all the claim limitations are taught or suggested by the prior art, which is required to establish a *prima facie* case of obviousness. In re Royka, 490 f.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Accordingly, Appellants respectfully

submit that claims 1 and 8 are allowable at least for the reasons set forth above.

Further, Appellants submit that claims 2-5, and 9-12 are allowable at least by virtue of their dependency on claims 1 and 8, respectively. As a result, reconsideration and reversal of the rejection of claims 1-5 and 8-12 is respectfully requested.

ISSUE 2: Whether claims 15 and 17 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle, and whether claims 16 and 18 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle and Son.

Independent claims 15 and 17 each recite a wireless terminal including a memory containing a collection of acceptable identifiers, and a processor that determines if a received identifier of a service station is at least one of the collection of acceptable identifiers.

As stated above with respect to claims 1-5 and 8-12, Mizikovsky explicitly discloses a mobile station, which stores one SID, i.e., the SID_s identifying the particular system to which the mobile station subscribes (Mizikovsky, column 6, lines 10-13). In section 4, page 4 of Paper No. 12, the Examiner acknowledges that Mizikovsky does not specifically disclose a memory containing a collection of acceptable identifiers. However, the Examiner asserts that it would have been obvious to one of ordinary skill in the art that Mizikovsky's mobile station was made to include a plurality of SIDs in its memory because Mizikovsky discloses that the status indicator is selectively controlled as the mobile station moves

through service cells of different providers (Paper No. 12, section 4, page 4)

Mizikovsky discloses that the mobile station merely compares the received SID_r to its stored SID_s to determine whether or not the corresponding base station is part of the home system (Mizikovsky, column 6, lines 13-15). Accordingly, the mobile station only needs to store one SID, specifically the SID of the home system, in order to make this determination. Although Mizikovsky discloses that the mobile station may have a preferred "HOME" status with systems other than its home system, the determination of this preferred status is performed by the base station whose coverage area the mobile station has entered. See Mizikovsky at column 7, lines 52-67, and column 9, lines 58-67.

Since Mizikovsky discloses that the preferred status of a mobile station in roaming systems is determined by the base stations, rather than the mobile station itself (see Id.), Mizikovsky provides no suggestion to store multiple base station identifiers in the mobile station's memory. The mobile station of Mizikovsky functions only to determine whether it has received a message from a base station within its home network, and therefore only compares the received SID_r to the SID of the home network, i.e., the stored SID_s (Id.).

For the reasons set forth above, the cited prior art fails to disclose a wireless terminal memory storing a plurality of acceptable identifiers, as required by independent claims 15 and 17. Therefore, Appellants

respectfully submit that independent claims 15 and 17 are allowable because the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, Appellants respectfully submit that claims 16 and 18 are allowable at least by virtue of their dependency on claims 15 and 17, respectively. Therefore, reconsideration and reversal of this rejection is respectfully requested.

ISSUE 3: Whether claims 6 and 13 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle and Son.

With respect to claims 6 and 13, the Examiner admits that Mizikovsky in view of Bartle fails to disclose that a call is automatically terminated after the vibrating or audible alert is produced if a call continuation indication is not received (Paper No. 12, section 5, page 5). The Examiner asserts that Son discloses a system and method in which a subscriber is alerted when he/she moves from a home region to a roaming region during a call and is provided with an option of terminating the call in Figure 4, column 5, lines 58-64, and column 6, line 44 through column 7, line 9 (Paper No. 12, section 5, pages 5-6). The Examiner further acknowledges that Son fails to disclose a predetermined time after which the call is automatically terminated if the subscriber has not provided a call continuation indication (Paper No. 12, section 5, page 6). The Examiner asserts that it would be obvious to a person of ordinary skill in the art at the time the invention was made to

modify Son to automatically terminate the call after a predetermined time or a user-programmed time (Id.).

The Examiner further asserts that it would have been obvious to one of ordinary skill in the art to combine the teachings of Mizikovsky and Bartle with the modified teachings of Son "in order to allow automatic termination of a call when the subscriber has failed to provide a call continuation indication, thereby protecting a subscriber of higher call charges when roaming to a visiting network." (Id.)

In regards to claims 3-5 and 10-12, the Examiner admits that none of Mizikovsky, Bartle, and Son specifically disclose that the call continuation indication can be an utterance or an activation of a key (Id.). However, the Examiner takes Official Notice that it is notoriously well known in the art of mobile telephones to provide indications or commands via speech (an utterance) or manually (activation of a key) using information provided in the mobile telephone display (Id.). The Examiner asserts that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify the combined teachings of Mizikovsky, Bartle, and Son with the well known teachings in the art of providing an indication or command to a mobile telephone via an utterance or activation of a key (Paper No. 12, section 5, pages 6-7).

To establish a *prima facie* case of obviousness, all claimed features must be taught or suggested by the prior art. Royka, 180 U.S.P.Q. 580.

Nothing in Mizikovsky, Bartle, and Son taken alone or in combination, discloses terminating a call a predetermined time period after producing an audible alert if no type of call continuation indication is received. The Examiner merely provides a conclusory statement that it would have been obvious to modify Son to include this feature without providing any objective evidence supporting such conclusions.

Appellants respectfully submit that the Examiner has failed to provide a teaching or suggestion of each claimed feature in the prior art, and therefore has failed to establish a *prima facie* case of obviousness with respect to claims 6 and 13. Accordingly, Appellants respectfully submit that dependent claims 6 and 13 are allowable at least for the reasons discussed above. Reconsideration and reversal of this rejection is therefore respectfully requested.

ISSUE 4: Whether claims 7 and 14 are unpatentable under 35 U.S.C. § 103 over Mizikovsky in view of Bartle and Son.

Independent claims 7 and 14 each recite automatically terminating a call after a user programmed time if a call continuation indication is not received.

In Paper No. 12, section 5, page 5, the Examiner admits that Mizikovsky and Bartle failed to disclose automatically terminating a call if a call continuation indication is not received. The Examiner further acknowledges that Son fails to disclose terminating a call if a call continuation indication is not received after a user programmed time (Id.

at pages 5-6). However, as discussed above with respect to claims 6 and 13, the Examiner merely makes a conclusory statement that it would have been obvious to "slightly modify" the teachings of Son to automatically terminate a call if no call continuation indication is received after a user programmed time (Id. at page 6).

Since the Examiner has failed to provide any teaching or suggestion in Mizikovsky, Bartle, and Son, either taken alone or in combination, the Examiner has failed to establish *prima facie* obviousness as to claims 7 and 14. Accordingly, Appellants respectfully submit that claims 7 and 14 are allowable at least for the reasons stated above. Accordingly, reconsideration and reversal of this rejection is respectfully requested.

(9) CONCLUSION

For the reasons advanced above, it is respectfully submitted that all the claims in this application are allowable. Thus, favorable reconsideration and reversal of the Examiner's rejection of claims 1-18 under 35 U.S.C. § 103(a) by the Honorable Board of Patent Appeals and Interferences, is respectfully requested.

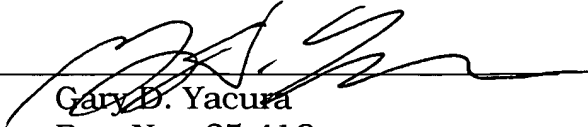
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Very truly yours,

HARNESS, DICKEY & PIERCE, P.L.C.

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(10) APPENDIX OF CLAIMS

Claim 1. A method for alerting a wireless terminal user of a handoff of a call from a first communication service station to a second communication service station, comprising the steps of:

receiving a handoff indicating message;

determining whether a received identifier of the second communication service station is at least one of a collection of acceptable identifiers; and

producing an audible alert during the call if the received identifier is not at least one of the collection of acceptable identifiers.

Claim 2. The method of claim 1, wherein the call is automatically terminated after producing the audible alert if a call continuation indication is not received.

Claim 3. The method of claim 2, wherein the call continuation indication is an utterance.

Claim 4. The method of claim 2, wherein the call continuation indication is an activation of a key.

Claim 5. The method of claim 4, further comprising the step of displaying information identifying at least one key as a call continuation key.

Claim 6. The method of claim 2, wherein the call is automatically terminated after a predetermined time if a call continuation indication is not received.

Claim 7. The method of claim 2, wherein the call is automatically terminated after a user programmed time if a call continuation indication is not received.

Claim 8. A method for alerting a wireless terminal user of a handoff of a call from a first communication service station to a second communication service station, comprising the steps of:

receiving a handoff indicating message;

determining whether a received identifier of the second communication service station is at least one of a collection of acceptable identifiers; and

producing a vibrating alert during the call if the received identifier is not at least one of the collection of acceptable identifiers.

Claim 9. The method of claim 1, wherein the call is automatically terminated after producing the vibrating alert if a call continuation indication is not received.

Claim 10. The method of claim 9, wherein the call continuation indication is an utterance.

Claim 11. The method of claim 9, wherein the call continuation indication is an activation of a key.

Claim 12. The method of claim 11, further comprising the step of displaying information identifying at least one key as a call continuation indication key.

Claim 13. The method of claim 9, wherein the call is automatically terminated after a predetermined time if a call continuation indication is not received.

Claim 14. The method of claim 9, wherein the call is automatically terminated after a user programmed time if a call continuation indication is not received.

Claim 15. A wireless terminal that alerts a user of a handoff of a call from a first communication service station to a second communication service station, comprising:

a receiver that receives a handoff indicating a message;

a memory containing a collection of acceptable identifiers; and

a processor that determines if a received identifier of the second communication service station is at least one of the collection of acceptable identifiers and activates an audible alert during the call if the received identifier is not at least one of the collection of acceptable identifiers.

Claim 16. The wireless terminal of claim 15, wherein the processor automatically terminates the call after activating the audible alert if a call continuation indication is not received.

Claim 17. A wireless terminal that alerts a user of a handoff of a call from a first communication service station to a second communication service station, comprising:

a receiver that receives a handoff indicating message;

a memory containing a collection of acceptable identifiers; and

a processor that determines if a received identifier of the second communication service station is at least one of the collection of acceptable identifiers and activates a vibrating alert during the call if the

received identifier is not at least one of the collection of acceptable identifiers.

Claim 18. The wireless terminal of claim 17, wherein the processor automatically terminates the call after activating the vibrating alert if a call continuation indication is not received.